

GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

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JUN 23 2004

Attorney Docket No. P20466

Mail Stop Amendment

TC 1700

Group Art Unit : 1733

In re application of Thomas DODT et al.

Serial No. : 09/800,477

Filed : March 8, 2001

Examiner : A. C. Johnstone

For : MOTOR VEHICLE WHEEL WITH A TIRE PLACED ON A WHEEL RIM AND A
SOUND-ABSORBENT INSERT AS WELL AS A PROCESS FOR MANUFACTURING
A SOUND-ABSORBENT INSERT

Mail Stop Amendment
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

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JUN 23 2004

TC 1700

Transmitted herewith is a Request for Reinstatement of Appeal in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ An Information Disclosure Statement, PTO Form 1449, and references cited.

☒ A Supplemental Appeal Brief (in triplicate).

☐ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 21	21	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 2	3	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

☒ N/A A Check in the amount of \$_____ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136)(a)(3).

Neil F. Greenblum
Reg. No. 28,394

3543



P20466.A12

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TC 1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Thomas DODT et al.

Group Art Unit: 1733

Appln. No. : 09/800,477

Examiner: A. C. Johnstone

Filed : March 8, 2001

For : MOTOR VEHICLE WHEEL WITH A TIRE PLACED ON A WHEEL RIM
AND A SOUND-ABSORBENT INSERT AS WELL AS A PROCESS FOR
MANUFACTURING A SOUND-ABSORBENT INSERT

REQUEST FOR REINSTATEMENT OF APPEAL

Commissioner For Patents
PO Box 1450
Alexandria, Virginia 23313-1450

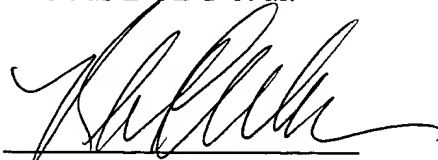
Sir:

In response to the non-final rejection of March 17, 2004, Appellant requests reinstatement of the appeal pursuant to M.P.E.P. 1208.02. Appellant is concurrently filing a Supplemental Appeal Brief and submits that the instant Appeal is proper pursuant to 35 U.S.C. section 134 because the claims have been twice rejected. Appellant notes that a Notice of Appeal was filed on May 7, 2003 and an Appeal Brief was filed (and all required fees paid) by the two month due date of July 7, 2003. Appellant submits that no additional fees are due in regards to the instant Supplemental Appeal Brief because Appellant has "once paid the fee for such appeal." pursuant to 35 U.S.C. section 134.

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The Commissioner is authorized to charge any additional fee, or to credit any overpayment, to Deposit Account No. 19-0089.

Respectfully submitted,
Thomas DODT et al.



Neil F. Greenblum

Reg. No. 28,394

FA 35,043

June 17, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
(703) 716-1191

P20466.A11



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JUN 23 2004
TC 1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Thomas DODT et al.

Group Art Unit: 1733

Appln. No. : 09/800,477

Examiner: A. C. Johnstone

Filed : March 8, 2001

For : MOTOR VEHICLE WHEEL WITH A TIRE PLACED ON A WHEEL RIM
AND A SOUND-ABSORBENT INSERT AS WELL AS A PROCESS FOR
MANUFACTURING A SOUND-ABSORBENT INSERT

SUPPLEMENTAL APPEAL BRIEF

Commissioner For Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the non-final rejection of March 17, 2004, Appellant requests reinstatement of the appeal pursuant to M.P.E.P. 1208.02. Appellant submits that the instant Appeal is proper pursuant to 35 U.S.C. section 134 because the claims have been twice rejected. Appellant notes that a Notice of Appeal was filed on May 7, 2003 and an Appeal Brief was filed (and all required fees paid) by the two month due date of July 7, 2003. Appellant submits that no additional fees are due in regards to the instant Supplemental Appeal Brief because Appellants have "once paid the fee for such appeal." pursuant to 35 U.S.C. section 134.

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A. REAL PARTY IN INTEREST

The real party in interest for the invention is Continental Aktiengesellschaft of Hannover, Germany by an assignment recorded in parent U.S. application No. 08/955,920 (now U.S. Patent No. 6,244,314) in the U.S. Patent and Trademark Office on May 15, 1998 at Reel 9188 and Frame 0393.

B. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences which would directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

C. STATUS OF CLAIMS

Claims 1-3 and 6-21 stand finally rejected under 35 USC 112, second paragraph, as being indefinite.

Claims 1-3 and 6-21 stand finally rejected under 35 USC 112, first paragraph, as containing new matter.

Claims 6 and 7 stands finally rejected under 35 USC 102(b) as being anticipated by European Application 0 663 306 (hereinafter EP '306).

Claims 4 and 5 are objected to as being dependent upon a rejected claim and would be allowable is presented in independent form. These claims are part of the instant Appeal.

D. STATUS OF AMENDMENTS

The Appeal Brief filed on July 7, 2003 was considered. The Examiner responded to the Appeal Brief with another non-final rejection dated March 17, 2004. The response to the Final Official Action filed on March 31, 2003 was considered, as indicated in the April 21, 2003 Advisory Action. Moreover, the Examiner indicated in the Advisory Action that the Amendment filed March 31, 2003 would be entered for purposes of Appeal. No amendment, other than the aforementioned Amendment, has been filed following the final rejection.

E. SUMMARY OF INVENTION

By way of non-limiting examples, the invention is directed to a vehicle wheel having an insert of sound absorbing material. Figs. 1 and 2 show a conventional wheel rim 1 for a tire 4 that is equipped with a drop base 2, rim beads 3, and bead seat surface 3a. A ring 5 of sound- absorbing material is situated inside the sealed interior space between the tire 4 and the wheel rim 1. The ring 5 is wrapped around and seated on the wheel rim 1 and can be made of open-pore foamed materials that are particularly well suited for air sound absorption. These materials can be, for example, PU-foams with a weight around 50 kg/m^3 and a mean pore content of approximately 2 mm^3 . Other effective sound-absorbing materials can also be utilized as starting material for the ring 5 such as felt, absorbing cotton, and materials of similar structure. Although the specification makes reference to foamed material rings, it is,

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as mentioned earlier, also possible to use other materials. *See paragraphs [0049] and [0050] of the specification.*

The foamed material ring 5 is constructed such that it covers the drop bed 2 but does not fill the drop bed 2 entirely and extends between the two tire beads of the tire 4. The foamed material ring 5 is otherwise constructed such that its cross section possesses a round to rectangular cross section. In the illustrated embodiment of Fig. 1, the cross section of the ring 5 resembles a rectangle with rounded edges. *See paragraph [0051] of the specification.*

The invention aims to make the air sound-absorbing inserts such that they weigh as little as possible. Moreover, it is preferable that the sound-absorbing material does not deform or does so only slightly when the tire is rolling. Preferably, the sound-absorbing material does not deform or does so only slightly when the tire experiences centrifugal forces which are noticeable at higher velocities. This resilience to centrifugal forces ensures that the desired, original, and designed sound-absorbing properties do not change during operation, i.e. during the rolling of the tire or vehicle wheel. *See paragraph [0052] of the specification.*

As can be seen in Figs. 1 and 2, the foamed material ring 5 is surrounded on its exterior by an acoustically transparent, woven mesh that is constructed in a mesh-like manner. This woven mesh acts as a support element. Moreover, the woven mesh 6 can completely wrap the insert 5 or it can wrap only that portion of the foamed material ring 5

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does not make contact on the wheel rim 1. This latter arrangement is particularly advantageous when the foamed material ring 5 is glued to the wheel rim 1. *See paragraph [0053] of the specification.*

The acoustically transparent woven mesh 6 contains fibers that have tensile strength in the circumferential direction and provide the foamed material ring 5 the required strength with respect to the centrifugal forces. These fibers with a particularly high degree of tensile strength can, for example, be made of nylon or of aromatic polyamide. In the axial direction, the fibers can be designed of a material exhibiting a lower thickness. This arrangement is advantageous because it reduces the weight of the ring 5. *See paragraph [0054] of the specification.*

The support element(s) in the form of woven mesh 6, when projected into a plane parallel to the progression of the support elements, provides acoustical transparency because it exhibits more empty surfaces than fibers. *See paragraph [0055] of the specification.*

The woven mesh 6 can be attached to the foamed material ring 5 in a number of ways. It can be attached by wrapping and subsequently closing the seam by welding. It can be attached by gluing. It can also be attached by utilizing a special locking mechanism. Finally, it can be sealed to the exterior in a tear-proof manner. If there is a seam, one should also, depending on the location of the seam, pay attention to the appropriate sound transparency. *See paragraph [0056] of the specification.*

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The foamed material ring may be installed by being pulled over the wheel rim as a closed ring. In this case, the foamed material ring 5 is preferably wrapped entirely or partially with the woven mesh 6 after assembly, i.e., after being placed on the rim. The foamed material ring 5 can be attached to the woven mesh 6 in a number of ways such as, by welding, thermal gluing, or similar measures. *See paragraph [0057] of the specification.*

The invention also contemplates that the foamed material ring 5 is already supplied with the support element 6 arranged on one side and/or on the lateral surfaces before it is assembled to the rim. In this case, the assembly of the arrangement can occur simply by rolling up the ring before insertion and pulling it over the wheel rim 1 in that position. *See paragraph [0058] of the specification.*

Fig. 1A shows one possible embodiment in which the foamed material ring 5 is pre-shaped in a ring-shaped manner and cut open or slit at one location for assembly. In this case, the support element 6 can also be mounted before the ring is assembled to the rim. The slit can be closed again by gluing it after assembly onto the rim. *See paragraph [0059] of the specification.*

Fig. 1B shows another embodiment of a ring 5. This embodiment utilizes two segments 5a. In this embodiment, the ring can thus be manufactured as two pieces. Alternatively, the ring can be manufactured as a single piece which is subsequently split into segments by cutting. The two parts can then be glued or attached in a manner similar to that

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described above with regard to Fig. 1A. *See paragraph [0060] of the specification.*

Instead of a woven mesh, the support element 6 can alternatively be perforated foil. The foil can, in particular, include a synthetic material. The foil can also preferably be designed to have uniform perforation. As in the embodiment where the support element is a woven mesh, one should pay attention to the acoustical transparency in this embodiment by letting the surface area of the holes dominate. The foil can be mounted in an adhesive fashion on the foamed material, in a manner that is analogous to the embodiment utilizing a woven mesh. *See paragraph [0061] of the specification.*

In order to ensure an optimal functioning of the present invention, it is important that the foamed material ring 5 is positioned as closely to the wheel rim 1 as possible. It can therefore also be advantageous to glue the ring 5 onto the wheel rim 1. *See paragraph [0062] of the specification.*

In the alternative embodiments illustrated in Figs. 1A and 1B, the foamed material ring 5 can be manufactured with an inner contour that corresponds to the contour of the wheel rim 1 with drop base. Further, the assembly of the ring onto the rim is facilitated by providing the foamed material ring in segmented form. *See paragraph [0063] of the specification.*

Fig. 3 shows another embodiment of the invention. Here, a foamed material strip 7 of appropriate width is utilized instead of the closed foamed material ring. The strip 7 is

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wrapped around the wheel rim 1 in at least two layers. The foamed material strip 7 can thus be wrapped in several layers. The strip 7 can also conform to the contour of the wheel rim 1. A single strip (as shown in Fig. 3A) can be utilized, for example, to facilitate its conformity to the contour of the wheel rim. Alternatively, more than one strip can also be used, for example, to facilitate its conformity to the contour of the wheel rim. *See paragraph [0064] of the specification.*

In order to improve the resilience of the ring 5 with respect to a centrifugal force, the foamed material strip can also contain support elements that are constructed as either a woven mesh or a foil. As described above, one can mount the support elements in this embodiment onto the completely wrapped ring, or, in a particularly advantageous way, the support elements can be applied, preferably in an adhesive manner, to the foamed material strip 7 before it is wrapped around the wheel rim. *See paragraph [0065] of the specification.*

Each layer of the wrapped foamed material strip 7 can contain a layer of support elements. In this embodiment, it is sufficient if only one side (which should be the outer side in the radial direction in the wrapped state) is coated with the support element. *See paragraphs [0066] and [0067] of the specification.*

It is particularly advantageous if the support elements exert a certain tension on the sound-absorbing material 5. This can be achieved in the embodiment which utilizes a woven mesh by using a support element material that is able to flex to a certain degree. In another

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preferred embodiment, this material strongly stiffens after surpassing a certain degree of flexing. It can be particularly advantageous to utilize materials that begin to stiffen in the range of 10 to 60% flexing. *See paragraph [0068] of the specification.*

In order to create a pre-tension, materials that shrink under thermal straining can be used for the support elements. Materials that shrink with thermal treatment can also be used for the foamed material of the ring. The foamed material ring can even be put under tension by each of these measures. This can ensure that the ring is seated on the wheel rim 1. *See paragraph [0069] of the specification.*

Fig. 4 shows another embodiment of the invention. In this embodiment, the foamed material of the foamed material ring 5' can itself act as a support element. In order to provide for such a design, the foamed material is processed such that longitudinal-shaped pores 5'a are created in the foaming process. These pores can, at least for the most part, point in one direction, i.e., the circumferential direction of the wheel rim or tire. In order to ensure that this occurs, as illustrated schematically in Fig. 7, the raw material for the foam (for example the polymer 7 and the foaming agent 8) can be admixed and fed through an extrusion jet 9 during the foaming process. In this way, the before-mentioned longitudinal pores 5'a can be formed. The extrusion direction, and thereby the direction of the pores 5'a, are created in the longitudinal form, which coincides with the direction of the ring 5' being created. Foamed material created in this manner thus exhibits a greater degree of firmness and stiffness in the

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circumferential direction than in the circumferential direction. In this way, the resilience to the centrifugal force is improved. *See paragraph [0070] of the specification.*

The invention also contemplates mixing fiber pulp into the material to be foamed either before or with the addition of the reacting additives. This is particularly useful for vehicle tires that are designed to be suitable for higher speeds and for which the centrifugal force up-take of the sound-absorbing insert should be appropriately larger. A foamed material ring 5" created in this way is illustrated in Fig. 5. During the extrusion process, fibers 10 are arranged so that they predominantly orient in one direction, i.e. in the direction of the longitudinally stretched pores 5"a. These fibers 10 act to increase the stiffness and firmness of the foamed material ring 5", in the direction of the circumference, without adding a large mass to the ring. Of course, the increased tensile strength created by the fibers 10 means that the assembly of the ring 5" on a single-piece wheel rim is hampered. However, it is still possible to assemble the ring to the rim because the fiber additives generally do not lower the tear flexibility. Because of the virtually unchanged softness of the ring 5" in the radial and the axial direction, and the at most average softness in the axial direction, an assembly process is conceivable whereby the ring 5" is pulled over the wheel bead by taking advantage of the drop base in wobble position. *See paragraph [0071] of the specification.*

Fig. 6 shows still another embodiment of a foamed material ring 5". This embodiment contains fibers 10' which are oriented in the circumferential direction but whose pores 5""a

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do not have a preferred orientation. The manufacturing of such a ring 5''' is, for example, possible by allowing the foaming of the raw material containing the fibers 10' only to occur after passing through the extrusion jet in which an appropriate orientation of the fibers 10' takes place. *See paragraph [0072] of the specification.*

With an appropriately equipped duplex extruder, it is possible to keep a radially outer layer on the ring free of reinforcing fibers. As a result, this layer can be kept thin, for example, between 0.5 and 2 mm, if it is to be arranged close to the wheel rim. The layer can also, for example, measure between 1 and 6 mm, if it is to be arranged close to the running surface. *See paragraph [0073] of the specification.*

The invention also contemplates utilizing different combinations of the individual embodiments. For example, an embodiment with oriented pore and/or fibers can be combined with an enclosing support element. Even though only sound-absorbing inserts arranged close to the wheel rim are illustrated, the present invention is not limited to such scenarios. Inserts in accordance with the invention can also be advantageously utilized in an arrangement that is close to the running surface, and in particular, in an arrangement immediately radially inside the running strip. *See paragraph [0074] of the specification.*

The invention encompasses other embodiments and/or features which are not described herein. However, all the claimed features have been explained with sufficient clarity to enable the reader to understand the invention.

F. ISSUES ON APPEAL

- (1) Whether the Specification Is Improperly Objected to Under 35 U.S.C. section 132, as Introducing New Matter.
- (2) Whether Claims 1-3 and 6-21 Are Improperly Rejected Under 35 U.S.C. section 112, Second Paragraph, as Being Indefinite.
- (3) Whether Claims 1-3 and 6-21 Are Improperly Rejected Under 35 U.S.C. section 112, First Paragraph, as Containing New Matter.
- (4) Whether Claims 6 and 7 Are Improperly Rejected Under 35 U.S.C. section 102(b) as Being Anticipated By EP 0 663 306 (EP '306).

G. GROUPING OF CLAIMS

The following groups of claims are considered to stand or fall together, but only for the purpose of this appeal: No claims stand or fall together.

H. ARGUMENT

- (1) The Objection of the Specification Under 35 U.S.C. section 132, as Introducing New Matter is in Error, the Examiner's Decision to Object to the Specification Should be Reversed, and the Application Should be Remanded to the Examiner.

Reversal of the objection to the specification under 35 USC 132, as introducing new matter is requested.

Appellant submits that the Board has jurisdiction over the instant objection because the issue of new matter has been set forth in both an objection and a rejection pursuant to

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MPEP 2163.06(II) which provides:

A rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.

The Examiner asserts that paragraphs [0029], [0031] and [0033]-[0035] of the instant continuation application, which were added at the time the instant application was filed, introduce new matter.

As Appellant has maintained all along, these paragraphs were added to the continuation application to provide antecedent support for the claims presented in the continuation application, and recite the same language used in the claims. For Example, paragraph [0029] corresponds to claim 1 of the instant application, paragraph [0031] corresponds to claim 3, and paragraphs [0033]-[0035] correspond to claims 6-14.

Furthermore, Appellant has consistently maintained all along that the language used in these paragraphs (and the claims) find clear support in the parent application No. 08/955,920 (Attorney Docket No. P16090.S01). A copy of this application has already been provided to the Examiner. Moreover, as the instant continuation claims benefit to the parent application and expressly incorporates by reference the disclosure of the parent application (see paragraph [0001] of the instant application), Appellant is entitled to rely on the entire

disclosure of the parent application.

Appellant further notes that the proper standard by which to measure whether the instant continuation application contains new matter is by comparing the disclosure of the instant application to that of the parent application. Thus, the following analysis will specifically sets forth the paragraphs in question and cites therein (in bold lettering) reference numbers and at least one location of support in the parent application, i.e. US patent Application No. 08/955,920 (document P16090.S01):

Paragraph [0029] states the following:

[0029] The instant invention is directed to a motor vehicle wheel that includes a wheel rim (1), a tire (4) having a tire interior enclosed by the wheel rim and the tire (see lines 1-3 of original claim 1), and the tire is mounted on the wheel rim (see line 1 of original claim 1). An insert (5) includes a ring-shaped sound-absorbing material (see lines 1-2 of original claim 1), and the insert is positioned within the tire interior (see line 2 of original claim 1). An acoustically transparent support element (6) (see line 4 of original claim 1) includes at least one layer of fibers oriented in a circumferential direction (see Fig. 2 shows one layer of fibers, i.e., the mesh 6, Fig. 3 shows many layers of the mesh, page 10, lines 9-10 described the support elements or mesh 6 as a layer, and original claim 7 explains that the mesh 6 has fibers extending in the circumferential direction) and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire (see lines 4-5 of original claim 1 and original claim 7). The centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction (see lines 1-3 of page 8), and the acoustically transparent support element is coupled to the insert (see original claim 13 and lines 5-6 of page 5 which states that the support element 6 is attached to the insert or ring 5).

See, in particular, page 3, lines 5-6, 10-11, 18-21; page 4, lines 2, 10-12, 16-18; page 5, line 29; page 6, line 7; page 7, line 21-23; page 8, lines 1-6; and page 10, lines 1-2, 15-16,

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22-25 of the parent application. Note that, e.g., page 8, lines 12-14 specifically indicates that the mesh can be attached by wrapping - a description which clearly and inherently supports language designating this as a layer. Page 8, lines 9-10 also clearly indicates that the wrapped support elements 6 can each be “a layer of support elements”. With regard to the assertion that the specification lacks support for the support element being “coupled” to the insert, Appellant directs the Board’s attention to page 3, lines 29-30, page 5, lines 5-6, page 7, lines 25-29, and in particular, page 8, lines 12-14 which specifically explains that support element (i.e., woven mesh) “can be attached to the foamed material ring 5”. See also page 8, lines 20-21 for how such attachment can be accomplished. See also page 8, lines 23-24 and Fig. 2. Finally, while Appellant acknowledges that the parent application does not specifically use the term “coupled” or “connected”, it should be apparent that the use of such terms are not new matter because such terms are encompassed (or find support in) the term “attached”, i.e., the term “attached” is defined by Webster’s II New College Dictionary as “[t]o connect or join”. Moreover, this same dictionary defines coupled as “[t]o link together: Connect”. A copy of select pages of this dictionary defining the terms connected, coupled and attached, was provided with the Appeal Brief filed on July 7, 2003.

Paragraph [0031] states the following:

[0031] Further, the acoustically transparent support element (6) may include a plurality of support elements layers radially arranged within the insert at discrete distances from each

other (see **original claims 4 and 11, and Figs. 3 and 3a**).

See, in particular, page 4, lines 4-5, page 9, lines 25-30, and page 10, lines 9-10 of the parent specification. Figs. 3 and 3a also clearly show an embodiment in which many support element layers are arranged in a radial manner and at discrete distances. Moreover, it is clear that at least some of these layers are arranged within the ring 5.

Paragraph [0033] states the following:

[0033] Moreover, the acoustically transparent support element **(6)** may be a perforated foil (see **original claim 8**). The foil can be formed in an isotropic manner (see **original claim 9**).

See, in particular, page 4, lines 20-23 and page 9, lines 9-14 of the parent specification.

Paragraph [0034] states the following:

[0034] According to another feature of the invention, the insert **(5)** can be formed as closed ring (see **original claim 10**). The closed ring may include of a strip **(7)** of sound-reducing material adapted to be wrapped several times in a ring-like manner (see **original claim 11**). The strip may have at least one side coupled to the acoustically transparent support element (see **original claims 12 and 13**). The acoustically transparent support element can be one of glued and welded to the strip (see **original claim 13**).

See, in particular, page 4, line 25 and, in particular page 4, lines 29-30, page 8, line 18, page 9, lines 25-30, and page 10, lines 1-16 of the parent specification. Figs. 3 and 3a

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also clearly show an embodiment in which an insert 5 is formed by a strip 7 that is wrapped in layers with all of its sides covered in support element, i.e., woven mesh.

Paragraph [0035] states the following:

[0035] The insert (5) can include a plurality of radially arranged insert layers (see **original claim 11 and Figs. 3 and 3a**). The acoustically transparent support element (6) may include a plurality of support element layers (see **original claims 11, and 12, and Figs. 3 and 3a**), and at least one of the support element layers can be positioned between each radially arranged insert layer (see **original claims 11 and 12, and Figs. 3 and 3a**).

See, in particular, page 4, lines 29-30, page 5, lines 1-3, page 9, lines 25-30 as well as page 10, lines 1-16 of the parent specification. Again, Figs. 3 and 3a clearly show an embodiment in which the insert 5 is made from a strip 7 that is wrapped in layers with all of its sides covered in support element, i.e., woven mesh.

Thus, it is believed that all of the language in paragraphs [0029], [0031] and [0033] through [0035] are fully supported by the original disclosure of the parent application. Accordingly, for the reasons given above, reversal of the Examiner's decision to finally object to the specification under 35 U.S.C. § 132 as introducing new matter is requested.

- (2) **The Rejection of Claims 1-3 and 6-21 Under 35 U.S.C. section 112, Second Paragraph, as Being Indefinite is in Error, the Examiner's Decision to Reject These Claims Should be Reversed, and the Application Should be Remanded to the Examiner.**

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Reversal of the rejection of claims 1-3 and 6-21 under 35 USC 112, second paragraph, as being indefinite is requested.

In the rejection, the Examiner made numerous assertions which Appellant is honestly unable to fully understand and contemplate. For example, rather than focusing on the specific claim language which the Examiner believes to be indefinite as required by current USPTO rules, the Examiner begins this rejection by pointing to what “Applicants now argue” and which language the Examiner believes Appellant is entitled to use. The Examiner then explains that Appellant purports to construe the claims in a particularly asserted manner which itself, the Examiner asserts, renders the claims indefinite. The Examiner then undertakes a detailed, and wholly inexplicable and confusing analysis of the claim language with numerous citations to case law. Appellant is honestly unable to unravel the basis for this rejection. However, Appellant will attempt to address each and every issue raised by the Examiner.

The Examiner asserts that claim 1 is indefinite, apparently because it recites an acoustically transparent support element comprising *at least one layer of fibers oriented in a circumferential direction* and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction, and *the acoustically transparent support element being coupled to the insert.*

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Apparently, the Examiner confuses fibers 10 and 10" of the embodiment shown in Figs. 5 and 6 for the fibers of the support element 6 shown in, e.g., Fig. 1. However, such an interpretation relates more to the Examiner's misunderstanding of the claim language, than to the claims themselves.

Appellant notes that the essential determination as to whether the claims satisfy 35 U.S.C. 112, second paragraph, requires a consideration as to whether the claims set forth the invention with a reasonable degree of precision and particularity. The definiteness of claim language is not analyzed in a vacuum, but rather, is considered in light of the prior art teachings and in view of Appellant's disclosure, as it would be interpreted by one having the ordinary level of skill in the pertinent art. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

In rejecting a claim under section 112, second paragraph, the Examiner is required to establish that one of ordinary skill in the art, when reading the claims in light of the specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989). If the disclosure and claims are sufficient for one skilled in the art to understand, the Examiner "should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirements." MPEP 2173.02.

Appellant submits that, contrary to the Examiner's assertions, claim 1 is entirely consistent with the original disclosure and would be entirely understandable to one having ordinary skill in the art having reviewed the original parent specification, claims and drawings. Appellant submits the following copy of claim 1 with citations to the parent application to ensure that the Examiner and the Board can clearly note the definiteness (and its support in the original disclosure) of the claim language:

1. A motor vehicle wheel (**see Fig. 1**) comprising:
a wheel rim (1);
a tire (4) having a tire interior enclosed by the wheel rim and the tire (**see lines 1-3 of original claim 1**);
the tire being mounted on the wheel rim (**see line 1 of original claim 1**);
an insert (5) comprising a ring-shaped sound-absorbing material (**see lines 1-2 of original claim 1**);
the insert being positioned within the tire interior (**see line 2 of original claim 1**);
an acoustically transparent support element (6) (**see line 4 of original claim 1**) comprising at least one layer of fibers oriented in a circumferential direction (**see Fig. 2 shows one layer of fibers, i.e., the mesh 6, Fig. 3 shows many layers of the mesh, page 10, lines 9-10 described the support elements or mesh 6 as a layer, and original claim 7 explains that the mesh 6 has fibers extending in the circumferential direction**) and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire (**see lines 4-5 of original claim 1 and original claim 7**), wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction (**see lines 1-3 of page 8**); and
the acoustically transparent support element being coupled to the insert (**see original claim 13 and lines 5-6 of page 5 which states that the support element 6 is attached to the insert or ring 5**).

The Examiner next asserts that claim 6 is indefinite because it recites the term "foil".

The Examiner characterizes this term as a relative term and even defines it as a very thin

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layer. The Examiner further asserts because the specification and the claims do not define its thickness, the scope of the claim is rendered uncertain. Appellant respectfully disagrees.

Appellant submits that there is full and clear support in the original specification for the term “foil” (see original claim 8 in the parent application). Appellant has never asserted that it is the inventor of a foil or foils and acknowledges that foils are entirely conventional. On the other hand, their use on an insert, as claimed and described in the instant application, is not believed to be conventional. Moreover, Appellant notes that the Examiner’s definition is not entirely accurate since the above-noted Webster’s II dictionary defines foil as a thin flexible sheet of metal. Moreover, Appellant has specifically expanded this definition to include foils which are also made of synthetic material. See page 9, lines 9-14 of the parent application. There is no contradiction in reciting a foil which includes (or consists of as recited in the specification) a synthetic material since there are many synthetic materials which have the form of a foil such as, e.g., Mylar®. Accordingly, Appellant submits that one of ordinary skill in the art would have no difficulty understanding what is meant by the term “foil” in the context of the invention, and the Examiner has not demonstrated otherwise.

The Examiner also asserts that claim 7 is indefinite because it contradicts claim 6. Specifically, the Examiner explains that because claim 6 recites that the foil extends in the circumferential direction, it cannot also be isotropic. Appellant respectfully disagrees. Appellant has full and clear support in the original specification for the term “isotropic” (see

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original claim 9 in the parent application). The term “isotropic” is defined as “identical in all directions” by the above-noted dictionary. Thus, a foil is isotropic if it is identical in all directions, e.g., it has the same thickness, texture, surface characteristics, material, etc., in all directions. On the other hand, this does not mean that the isotropic nature of the foil changes when it is oriented in a certain way such as, e.g., circumferentially. Surely, a foil does not automatically, as the Examiner appears to assert, lose its isotropic characteristic simply because one shapes, orients, moves it to a particular position, or fashions it in a particular manner.

The Examiner next asserts that claim 10 is indefinite because it is inconsistent with the specification. Appellant respectfully disagrees. Claim 10 recites “[t]he motor vehicle wheel in accordance with claim 9, the strip having at least one side coupled to the acoustically transparent support element.” On the other hand, original claims 11-13 and Figs. 3 and 3a clearly describe and show a strip 7 that has a support element (i.e., woven mesh) covering one or more of the sides. Moreover, paragraph [0065] explains that the support element can be either a woven mesh or a foil that is adhesively applied to the strip. As is well known, something that is adhesively attached is certainly “coupled”. Finally, paragraph [0067] explains that “[i]n this embodiment, it is sufficient if only one side (which should be the outer side in the radial direction in the wrapped state) is coated with the support element” (emphasis added).

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Accordingly, Appellant submits that, measured against the correct standard enunciated above, none of the claims are indefinite. Thus, for reasons given above, reversal of the Examiner's decision to finally reject claims 1-3 and 6-21 under 35 U.S.C. § 112, second paragraph, is requested.

(3) The Rejection of Claims 1-3 and 6-21 Under 35 U.S.C. section 112, First Paragraph, as Containing New Matter is in Error, the Examiner's Decision to Reject These Claims Should be Reversed, and the Application Should be Remanded to the Examiner.

Reversal of the rejection of claims 1-3 and 6-21 under 35 USC 112, first paragraph, as containing new matter is requested.

In the rejection, the Examiner again made numerous assertions which Appellant is honestly unable to fully understand and contemplate. For example, the Examiner purports to inform Appellant of which language Appellant has literal generic support for, and which subgeneric and species language Appellant is entitled to claim. The Examiner then again undertakes a detailed, and wholly inexplicable and confusing analysis, of the claim language with numerous citations to case law. Again, Appellant is honestly unable to unravel the basis for this rejection. However, Appellant will attempt to address each and every issue raised by the Examiner.

The Examiner has asserted that there is no literal support in the parent application for

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the language recited in claim 1. Moreover, the Examiner has gone to great lengths to opine on what claim language would have such support. The Examiner then concludes that there is no support for the phrases “coupled to” and “at least one layer of fibers oriented in a circumferential direction.” Appellant respectfully disagrees.

Appellant notes that “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” See *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774 (Fed. Cir. 2002) noting *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995). A copy of the *All Dental Prodx* case has already been provided to the Examiner.

Apparently, the Examiner has failed to consider the fact that the original drawings, the specification and the claims all make up the original disclosure in evaluating section 112, first paragraph. The Examiner is also apparently under the erroneous belief that claim terms must find exact “literal support” in the disclosure. Appellant submits that the Examiner is entirely incorrect on both counts.

Appellant submits claim 1 is entirely supported with the original disclosure of the parent application. Appellant submits the following copy of claim 1 with citations to the parent application to ensure that the Examiner and the Board can clearly note its support in

the original disclosure:

1. A motor vehicle wheel (see Fig. 1) comprising:
a wheel rim (1);
a tire (4) having a tire interior enclosed by the wheel rim and the tire (see lines 1-3 of original claim 1);
the tire being mounted on the wheel rim (see line 1 of original claim 1);
an insert (5) comprising a ring-shaped sound-absorbing material (see lines 1-2 of original claim 1);
the insert being positioned within the tire interior (see line 2 of original claim 1);
an acoustically transparent support element (6) (see line 4 of original claim 1) comprising at least one layer of fibers oriented in a circumferential direction (see Fig. 2 shows one layer of fibers, i.e., the mesh 6, Fig. 3 shows many layers of the mesh, page 10, lines 9-10 described the support elements or mesh 6 as a layer, and original claim 7 explains that the mesh 6 has fibers extending in the circumferential direction) and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire (see lines 4-5 of original claim 1 and original claim 7), wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction (see lines 1-3 of page 8); and
the acoustically transparent support element being coupled to the insert (see original claim 13 and lines 5-6 of page 5 which states that the support element 6 is attached to the insert or ring 5).

With regard to the term “coupled to”, Appellant again reminds the Examiner that Figs. 1 and 2 show a woven mesh support element 6 in the form of a layer covering the insert 5. Indeed, Fig. 3 shows another embodiment which uses many layers or woven mesh support elements 6. It is also clear from, e.g., page 5, lines 5-6 and page 9, lines 9-14 of the parent application, and paragraphs [0021], [0056] and [0061] of the instant continuation application, that the specification described various ways that the support element 6 can be attached, i.e., coupled to or connected to, the ring 5. For example, paragraph [0056] specifically states that

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“[t]he woven mesh 6 can be attached to the foamed material ring 5”. As discussed above, the term “coupled” finds support in Appellant’s use of the term “attached”.

With regard to the term “at least one layer of fibers oriented in a circumferential direction”, Appellant notes that Figs. 1 and 2 clearly show a woven mesh support element 6 with fibers oriented in the circumferential direction, i.e. most of the fibers shown in Fig. 2 are clearly oriented in the circumferential direction. Original claim 7 and clearly indicates that the fibers of the mesh 6 can be oriented to provide tensile strength in the circumferential direction. See also page 4, lines 9-12 of the parent application.

Finally, Appellant also incorporates herein the comments outlined above in the new matter objection with regard to paragraph [0029].

With regard to the Examiner’s assertion that the specification does not provide support for a foil that is oriented in a circumferential direction, Appellant notes that Figs. 1 and 2 and page 9, lines 9-14 clearly provide sufficient support for this feature, relative to section 112, first paragraph. Indeed, this language finds support in the parent application on e.g., page 4, lines 20-23, page 9, lines 9-14 of the parent specification. There it is explained that the foil is disclosed as an alternative to a woven mesh which can be oriented in the circumferential direction. Indeed, on page 9, lines 13-14, it is specifically indicated that the foil can be mounted to the insert ring in an “analogous” manner, e.g., in a layer or layers.

Appellant notes the Examiner’s comments that the term “extending” would be more

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fully supported by the original disclosure that the term “oriented”. However, Appellant disagrees with this assertion and submits that the original disclosure provides sufficient inherent support for the support element 6 being a foil which is oriented in the circumferential direction (see Figs. 1a-3a and original claims 1-4, 8 and 9 of the parent application).

Appellant is mindful of the Examiner’s extensive discussion in support of this rejection and has fully considered the Examiner’s comments and the case law cited by the Examiner. However, it has not escaped Appellant’s attention that the Examiner has failed to properly evaluate the claim language on the basis of whether the claims recite features which are fully supported by the original disclosure. Appellant has, throughout the prosecution of this application, gone to great lengths to point out how each claim is fully supported by the original disclosure. Accordingly, Appellant reiterates and incorporates those arguments herein.

Additionally, while Appellant has pointed out that each feature is in fact literally and/or inherently disclosed and/or supported in the instant specification, Appellant again notes that features can also find support, or be inherently disclosed, in the figures.

Accordingly, Appellant submits that, measured against the correct standard enunciated above and the disclosure of the parent application, none of the claims contain new matter. Thus, for reasons given above, reversal of the Examiner’s decision to finally reject claims

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1-3 and 6-21 as containing new matter is requested.

- (4) The Rejection of Claims 6 and 7 Under 35 U.S.C. section 102(b) as Being Anticipated By EP '306 is in Error, the Examiner's Decision to Reject These Claims Should be Reversed, and the Application Should be Remanded to the Examiner.**

Reversal of the rejection of claims 6 and 7 under 35 USC 102(b) as being anticipated by EP '306 is requested.

In the rejection, the Examiner asserted that this document discloses all the features recited in these claims. Moreover, the Examiner has explained that she may properly disregard the feature "perforated foil" apparently because Appellant has not defined the foil thickness in the specification. Appellant respectfully traverses this rejection and the assertions therein.

Appellant submits that the rejection is entirely improper because this document does not disclose all the recited features of at least claim 6.

Appellant notes that, for an anticipation rejection under 35 U.S.C. § 102(b) to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Notwithstanding the Office Action assertions as to what this document discloses, Appellant submits that this document fails to disclose, inter alia, an acoustically transparent support element comprising *at least one layer of perforated foil oriented in a circumferential*

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direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of perforated foil oriented in the circumferential direction, as recited in independent claim 6.

Appellant does not dispute that, on page 6, lines 7-17 of the English language translation of EP '306, it specifically explains that the tube containing a foam sound-absorbing material can be perforated with regularly distributed holes. However, it is clear from page 9, lines 7-19 and lines 16-23 of page 10 that the tube is disclosed as being made of rubber, not foil.

The Examiner has identified no disclosure in this document with regard to the recited foil. Nor is it discernable whether EP '306 even discloses any perforated foil. Instead, the Examiner has chosen to disregard a feature which is clearly and positively recited. Further still, the Examiner has stated, without pointing to any supportive disclosure in the document, that the perforated rubber tube constitutes disclosure for a perforated foil. Moreover, conspicuously absent from the Examiner's analysis is any legal basis for disregarding this feature or any cases which support the Examiner's assertions. Thus, Appellant submits that this rejection is clearly and entirely improper.

Appellant additionally submits that the Examiner has set forth no legal basis for disregarding and/or for not giving patentable weight to the above-noted recited features.

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Appellant submits that the Examiner is not free to disregard features which describe and limit the invention. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1306, 51 USPQ2d 1161, 1166 (Fed. Cir. 1999).

For the foregoing reasons and because EP '306 fails to disclose the above-noted features of the instant invention, Appellant submits that EP '306 fails to disclose each and every recited feature of the instant invention. Accordingly, Appellant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b) and that the instant rejection is improper.

With regard to claim 7, Appellant notes that this claim depends from claim 6 and further recites that the foil is isotropic. As EP '306 lacks any disclosure with regard to a foil, it simply cannot render unpatentable a claim which recites that the foil is isotropic.

Thus, for reasons given above, reversal of the Examiner's decision to finally reject claims 6 and 7 is requested. Further, Appellant requests that the application be remanded to the Examiner for allowance.

I. CONCLUSION

For the reasons advanced above, Appellant submits that the objection and rejections are erroneous and that the Examiner's decision to reject claims 1-3 and 6-21 should be reversed. Claims 1-3 and 6-21 are not indefinite, do not introduce new matter, and are

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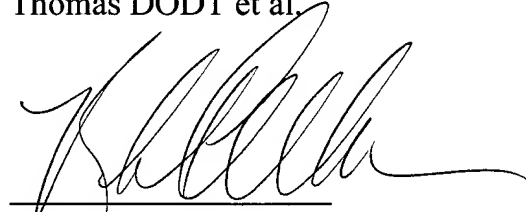
otherwise allowable over the art of record.

This appeal brief is being submitted in triplicate, pursuant to 37 CFR 1.192(a).

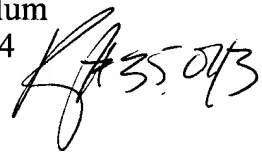
Pursuant to 35 USC § 134, Appellant submits that no fee is due for the instant Appeal Brief since Appellant has already "once paid the fee for such appeal".

The Commissioner is authorized to charge any additional fee, or to credit any overpayment, to Deposit Account No. 19-0089.

Respectfully submitted,
Thomas DODT et al.

A handwritten signature in black ink, appearing to read "Neil F. Greenblum", written over a horizontal line.

Neil F. Greenblum
Reg. No. 28,394

Handwritten initials "JF" followed by the date "35.07.3" in black ink.

June 17, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
(703) 716-1191

Attachment: Appendix

APPENDIX

Claims on Appeal:

1. A motor vehicle wheel comprising:

a wheel rim;

a tire having a tire interior enclosed by the wheel rim and the tire;

the tire being mounted on the wheel rim;

an insert comprising a ring-shaped sound-absorbing material;

the insert being positioned within the tire interior;

an acoustically transparent support element comprising at least one layer of fibers oriented in a circumferential direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction; and

the acoustically transparent support element being coupled to the insert.

2. The motor vehicle wheel in accordance with claim 1, the insert having a surface open to the tire interior at least over a portion of its cross-section; and

the acoustically transparent support element wrapping the surface of the insert.

3. The motor vehicle wheel in accordance with claim 1, the acoustically transparent support element comprising a plurality of support element layers radially arranged within the insert at discrete distances from each other.

6. A motor vehicle wheel comprising:

a wheel rim;

a tire having a tire interior enclosed by the wheel rim and the tire;

the tire being mounted on the wheel rim;

an insert comprising a ring-shaped sound-absorbing material;

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the insert being positioned within the tire interior;

an acoustically transparent support element comprising at least one layer of perforated foil oriented in a circumferential direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of perforated foil oriented in the circumferential direction; and

the acoustically transparent support element being coupled to the insert.

7. The motor vehicle wheel in accordance with claim 6, the foil being isotropic.

8. The motor vehicle wheel in accordance with claim 1, the insert being a closed ring.

9. The motor vehicle wheel in accordance with claim 8, the closed ring comprising a strip of sound-absorbing material wrapped several times in a ring-like manner.

10. The motor vehicle wheel in accordance with claim 9, the strip having at least one side coupled to the acoustically transparent support element.

11. The motor vehicle wheel in accordance with claim 9, the acoustically transparent support element is one of glued and welded to the strip.

12. The motor vehicle wheel in accordance with claim 8, the acoustically transparent support element is one of glued and welded to the closed ring.

13. The motor vehicle wheel in accordance with claim 1, the insert comprising a plurality of radially arranged insert layers.

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14. The motor vehicle wheel in accordance with claim 13, the acoustically transparent support element comprising a plurality of support element layers; and

at least one of the support element layers is positioned between adjacent radially arranged insert layers.

15. The motor vehicle wheel in accordance with claim 1, the insert comprising a plurality of circumferential segments joined after assembly.

16. The motor vehicle wheel in accordance with claim 1, the acoustically transparent support element adding, at least in the circumferential direction, tension to the sound-absorbing insert.

17. The motor vehicle wheel in accordance with claim 1, wherein the insert is mounted at the wheel rim.

18. The motor vehicle wheel in accordance with claim 1, wherein the ring-shaped sound-absorbing material comprises an open-pore foamed material.

19. The motor vehicle wheel in accordance with claim 18, wherein the open-pore foamed material comprises a polyurethane (PU) foam.

20. The motor vehicle wheel in accordance with claim 18, wherein the open-pore foamed material comprises a weight around 50 kg/m^3 and a mean pore content of approximately 2 mm^3 .

21. The motor vehicle wheel in accordance with claim 1, wherein the ring-shaped sound-absorbing material comprises at least one of a felt and an absorbing cotton.